REMARKS

The Office Action mailed on August 10, 2004, has been received and its contents carefully reviewed. By the above Amendment, Applicant amended the specification, abstract, and claims 1, 6, 7, 8, 15 and 17 to correct typographical errors, and added new dependent claims 21-26, to more distinctly highlight the features of the present invention. The Examiner had asserted the typographical errors caused claims 1, 6, and 7 to be unclear. Claims 1-26 are now pending in the application. Support for the amendments may be found at least on page 3, lines 24-28; page 12, lines 22-31; page 13, lines 4-20; page 14, lines 24-29; and page 16, lines 6-29. Applicant respectfully submits that no new matter is presented by entry of this Amendment and that the application is in condition for allowance.

Applicants wish to thank Examiner Nobahar and SPE Barron for conducting the personal interview with Applicants' representatives on January 31, 2005. Although no agreement was reached, the claims as substantially submitted herewith were discussed and which patentably distinguish over Downs et al. in U.S. Patent No. 6,226,618, as further set forth herein.

A. Information Disclosure Statement

The Examiner asserts that the information disclosure statement filed on August 30, 2002, fails to comply with the provisions of 37 CFR §§ 1.97, 1.98 because the foreign patent documents and other non-patent literature listed in the IDS form PTO-1449 have not been submitted. Applicant respectfully asserts that these documents were provided to the USPTO concurrently with the Information Disclosure Statement filed on August 30, 2002. On the postcard submitted to the USPTO on August 30, 2002, copies of 139 documents were itemized as being a part of the filed materials. From Applicant's preliminary investigation, it appears that these materials have become separated from the Information Disclosure Statement after the materials were received at the USPTO. Applicant respectfully requests that the Examiner explore possible avenues to locate these documents before Applicant is required to re-submit the references.

B. Claim Rejections under 35 U.S.C. § 112

Claims 1, 6, and 7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1, 6, and 7 were amended above to correct

typographical errors that may have rendered these claims unclear. In view of the amendments above, Applicant respectfully requests reconsideration and withdrawal of this rejection.

C. Claim Rejections under 35 U.S.C. § 102

Claims 1-20 stand rejected under 35 U.S.C. § 102, as being anticipated by Downs et al. in U.S. Patent No. 6,226,618 (the '618 patent) as indicated beginning on page 3 of the August 10, 2004, Office Action. In view of the amendments above and the remarks below, Applicant respectfully requests reconsideration and withdrawal of this rejection.

The present invention is generally directed to a system and method for the secure distribution and consumption of electronic documents using a standard rendering engine. The documents have associated usage rights. In a preferred embodiment, a server stores at least one of the documents in computer-readable form. A client having a standard application program including a rendering engine capable of rendering unencrypted documents for viewing is operated by a user. The client and the server are coupled by a communications network. A rights management module receives a request from the client for at least one of the documents on the server and delivers the document and a set of rights associated with the document to the client. A connection module adapted to be attached to the rendering engine receives the set of rights associated with the document. A user interface module adapted to be attached to the rendering engine controls the user's access to the document in accordance with the list of rights for the user associated with the document.

For example, independent claim 1, as amended, recites:

> A system for distributing and enforcing use of digital documents having usage rights associated therewith, said system comprising:
> a server having at least one document stored thereon in computer readable form;
> a client having a standard application program including a rendering engine capable of rendering unencrypted documents for viewing;
> a communications network coupled to said client and said server;
> a rights management module for receiving a request for at least one of the documents from said client and delivering the at least one document and a set of rights associated with and for enforcing use of the at least one document to said client;
> a connection module adapted to be attached to said rendering engine for receiving the list of rights associated with the at least one document, for verifying the integrity of the client by confirming a user interface module is attached to said rendering engine, and for verifying the integrity of the rendering engine;
> a user interface module adapted to be attached to said rendering engine for controlling access by the client to the at least one document for enforcing use of the at least one document in accordance with the set of rights associated with said at least one document.

By contrast, the '618 patent delivers digital content through an unsecured distribution infrastructure (see col. 7, lines 24-26). That is, the '618 patent uses secure containers with storage and distribution separate from the control of its unlocking and use, and that only users who have decryption keys can unlock the encrypted content (see col. 7, lines 28-32). While the '618 patent appears to disclose a client-server environment, there is no disclosure of a rights management module for receiving a request from the client for at least one of the documents and delivering the at least one document and a set of rights associated with the at least one document to the client as required by claim 1 of the present application. The Examiner points to the entire rights management section of the '618 patent to support his assertion that the '618 patent discloses a rights management module as previously recited in claim 1 of the present application. But, upon examination, this section of the '618 patent merely discloses a way of managing electronic document rights. It does not, however, disclose the rights management module recited in claim 1 of the present application, as amended. To wit, the rights management module recited in claim 1, as amended, is for receiving a request for at least one of the documents from the client and delivering the at least one document and a set of rights associated with and for enforcing use of the at least one document to the client by verifying the integrity of the client by confirming a user interface module is attached to the rendering engine, and by verifying the integrity of the rendering engine. As indicated beginning on page 13, line 4 of the present specification, the present invention includes a novel feature of using a standard, non-modified, rendering engine to leverage the existing infrastructure of content creation and distribution, while enabling the system of the invention with a new ability to limit the use of content that is distribute and made available in an unencrypted format to a rendering module. As recited in claim 1, this is accomplished by writing a UI module that intercepts UI events headed to the standard rendering engine. This feature is not even remotely disclosed by the '618 patent.

In contrast, the rights management of the '618 patent, is distributed among the operating components of the system. Secure container technology is employed to distribute encrypted content among the system components (see col. 7, lines 1, 16, and 17). Content providers are distributors authorized to package independent content for further distribution (see col. 9, lines 5-7). Electronic content stores market the content, while a clearinghouse provides licensing authority and record keeping for transactions that relate to the use of the content housed in a secure container (see col. 10, lines 50-53). This is similar to the conventional document

distribution system described in the present application where a clearinghouse is known to collect requests from users as well as payment information (see present application, starting on page 9, line 12). However, the present application goes on to distinguish the present system from that of prior electronic document distribution systems.

For example, in the present invention, the connection module on the server need not be used to regulate who has access to the content, but rather can be used to check to see if the user interface (UI) module is employed by the rendering engine on the client and to verify the integrity of the rendering engine. If the rendering engine has the UI module employed to prevent illegal use of the content (e.g., for screen print, print, save as, etc.), the content is delivered to the client. Support for these features may be found beginning on page 14, line 46 of the present specification.

Further, the rights management module of the present invention is a server side component that identifies which rights are associated with each document. In the '618 patent, rights management is implemented through a set of functions distributed among the operating components of the system (see col. 7, lines 1-2). By employing the rights management module on the server side of the present invention, the appropriate list of rights are delivered along with the document, via the communications network to the connection module of the client. That is, the rights travel with the document. This distinction is recited in claim 1 where the rights management module is "...delivering the at least one document and a set of rights associated with and for enforcing use of the at least one document to said client..." (emphasis added).

The '618 patent is directed to delivering content as an encrypted block of data and then employs a browser to load a plugin to handle the encrypted block of data. By contrast, the present invention, as described starting on page 15, line 21, creates a new protocol that the browser can understand. The new protocol is accessed from the browser as a new protocol (for example, cg:// instead of http://). This allows the browser to retrieve data from the server over a continuous link instead of having to create encrypted documents as in the '618 patent. For example, in the present invention, the interaction between client and server does not have to be "packeted" because a novel protocol is used that allows the client browser to connect dynamically back to the server over the secure link in real time. In contrast, the '618 patent packages a body of html content in an encrypted block of data and delivers it to the client. When saving this file, the entire page and all of the associated images, et cetera are downloaded and stored. If the '618 patent were used to protect real-time stock market data or otherwise

dynamically changing data, each update would require a new encrypted package of data, while the present invention would allow constant protected updates over a secure link.

Additionally, the Examiner appears to equate the rights management module of the present application to the end-user device of the '618 patent and points to column 11, lines 30-53 to support this assertion. However, the cited portion of the '618 patent merely discloses that the end-user device houses an end-user player application and that the end-user player application performs secure container processing to enable rights management (see col. 11, lines 31 and 38) and gives the example of an end-user device being a personal computer (see col. 79, lines 16-17). The end-user player application of the '618 patent is analogous to a digital content player (see col. 83, lines 28-30). It does not disclose, nor is any mention made, of a rights management module for receiving a request for at least one of the documents from said client and delivering the at least one document and a set of rights associated with and for enforcing use of the at least one document to the client as recited in claim 1, as amended. As such, Applicant respectfully requests additional clarification regarding this interpretation be provided in the Examiner's next communication. In the absence of additional explanation regarding these claimed elements, Applicant respectfully requests the withdrawal of the rejection of claim 1.

In addition, the '618 patent fails to disclose a connection module adapted to be attached to said rendering engine for receiving the list of rights associated with the at least one document and for verifying the integrity of the client by confirming a user interface module is attached to said rendering engine, and for verifying the integrity of the rendering engine, as currently recited in claim 1. While the Examiner previously pointed to col. 11, lines 30-53 and Figure 1D as meeting the previous claimed limitations, the cited section of the '618 patent merely discloses that the end-user device houses an end-user player application and that the end-user player application performs secure container processing to enable rights management (see col. 11, lines 31 and 38). The Examiner asserts that the (end-user) player application corresponds to the recited connection module and connected to [sic] the helper application of the browser (see Office Action, page 4). No further explanation is forthcoming. However, the end-user player application of the '618 patent is analogous to a digital content player (see col. 83, lines 28-30). At its simplest, it renders content, such as playing songs or videos. At another level, it provides the end-user(s) a tool for managing his/her digital content library (see col. 83, lines 33-36). The '618 patent does not disclose, nor is any mention made, of a connection module adapted to be attached to the rendering engine for receiving the list of rights associated with the at least one document and for verifying the integrity of the client by confirming a user interface module is

attached to said rendering engine, and for verifying the integrity of the rendering engine, as currently recited in claim 1. As such, Applicant respectfully requests additional clarification regarding this interpretation be provided in the Examiner's next communication. In the absence of additional explanation regarding these claimed elements, Applicant respectfully requests the withdrawal of the rejection of claim 1.

Applicant respectfully submits that the '618 patent does not disclose each element of claim 1 of the present invention, as amended. Anticipation is established only when a single reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. Therefore, the '618 patent cannot and does not anticipate claim 1 of the present invention under 35 U.S.C. § 102. Applicant respectfully submits that claim 1, as amended, is allowable over the cited reference and requests that the rejection of claim 1 under 35 U.S.C. § 102 be withdrawn.

With regard to claims 2-7, these claims are dependent upon claim 1 and thereby include all the limitations of independent claim 1 while reciting additional features of a system of the present invention. Applicant respectfully traverses the rejection of claims 2-7 for similar reasons as outlined above with regard to the rejection of claim 1 under 35 U.S.C. § 102. As discussed above, the cited reference fails to disclose all the elements and limitations recited in independent claim 1 of the present application.

Additionally, for example with regard to dependent claim 2, the cited reference fails to disclose a connection module where the connection module is operative to detect whether the user interface module is attached to the rendering engine and for providing at least one of the documents to the rendering engine if the user interface module is attached to the rendering drive as recited in claim 2.

While the Examiner points to the entire "End-User Device(s)" section of the '618 patent (col. 11, lines 30-53 and Figure 1D) as meeting this claimed limitation, the cited section of the '618 patent merely discloses that the end-user device houses an end-user player application and that the end-user player application performs secure container processing to enable rights management (see col. 11, lines 31 and 38). No further explanation is forthcoming. However, the end-user player application of the '618 patent is analogous to a digital content player (see col. 83, lines 28-30). At its simplest, it renders content, such as playing songs or videos. At another level, it provides the end-user(s) a tool for managing his/her digital content library (see col. 83, lines 33-36). It does not disclose, nor is any mention made, of a connection module "operative to detect whether said user interface module is attached to said rendering engine and

for providing the at least one of the documents to said rendering engine if said user interface module is attached to said rendering drive," as required by claim 2. As such, Applicant respectfully requests additional clarification regarding this interpretation be provided in the Examiner's next communication. In the absence of additional explanation regarding these claimed elements, Applicant respectfully requests the withdrawal of the rejection of claim 2.

Similarly, dependent claims 3-7 and 21-22 recite additional features and limitations of their dependent or independent claims, while reciting additional features of a system of the present invention. Applicant respectfully submits that claims 3-7 and 21-22 are allowable for similar reasons as outlined above with regard to the rejections of claim 1 and claim 2 under 35 U.S.C. § 102. As discussed above, the cited reference fails to disclose all the elements and limitations recited in independent claim 1 and in dependent claim 2 of the present application. As such, Applicant respectfully submits that claims 3-7 and 21-22 are patentable under 35 U.S.C. § 102.

Independent claim 8 and 15 and claims dependent therefrom are allowable over the '618 patent on their own merits, and for at least the reasons argued above with respect to independent claim 1. For example, independent claim 8, as amended, recites:

> A method for distributing and enforcing use of digital documents having one or more usage rights associated therewith, said method comprising the steps of:
> storing at least one document on a server in computer readable form;
> accessing the server with a client having a standard application program including a rendering engine capable of rendering unencrypted documents;
> receiving a request for at least one of the documents from the client;
> delivering the at least one of the documents and a set of rights associated with and for enforcing use of the at least one of the documents to the client;
> receiving the list of rights associated with the at least one of the documents with a connection module attached to the rendering engine and that verifies the integrity of the client by confirming a user interface module is attached to said rendering engine and verifies the integrity of the rendering engine;
> controlling access by the client to the at least one of the documents for enforcing use of the at least one document in accordance with the set of rights associated with the at least one of the documents through a user interface module attached to the rendering engine; and

independent claim 15, as amended, recites:

> In a computer architecture including a server having documents stored thereon, a start page for accessing the documents, and a client running an

application program having a rendering engine, a method of distributing and enforcing use of documents comprising the steps of:

  installing a rights management module on the server;

  attaching a user interface module and a connection module to the rendering engine;

  creating a secure start page on the server;

  placing the documents in directory;

  programming the rights management module to include a pointer to the directory;

  encrypting an address to the directory;

  modifying the secure interface display to reference the user interface module and the start page;

  verifying the integrity of the client with the connection module by confirming the user interface module is attached to the rendering engine;

  verifying the integrity of the rendering engine with the connection module;

  unencrypting the address to the directory with the connection module to permit access to the start page and the documents on the server; and

  enforcing use of the documents with the user interface module in accordance with a set of rights associated with the documents.
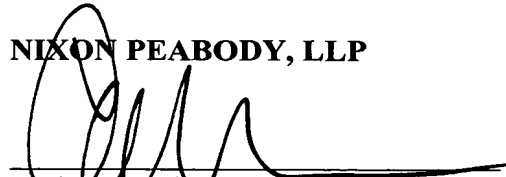
With regard to dependent claims 9-14, 16-20, and 23-26, these claims are dependent upon independent claims 8 or 15 and thereby include all the limitations of independents claim 8 or 15, while reciting additional features of a method of the present invention. Applicant respectfully submits that claims 9-14, 16-20, and 23-26 are allowable for similar reasons as outlined above with regard to the rejections of claim 8 and claim 15 under 35 U.S.C. § 102. As discussed above, the cited reference fails to disclose all the elements and limitations recited in independent claims 1 and 15 of the present application. As such, Applicant respectfully submits that claims 9-14, 16-20, and 23-26 are patentable under 35 U.S.C. § 102.

D. Conclusion

In view of the above amendments and remarks, Applicant respectfully requests the Examiner's reconsideration of this application and the timely allowance of the pending claims.

Respectfully submitted,

NIXON PEABODY, LLP

Carlos R. Villamar
Registration No. 43,224

Customer Number: 22204
NIXON PEABODY LLP
401 9th Street, N.W., Suite 900
Washington, DC 20004
(202) 585-8000 – Telephone
(202) 585-8080 - FAX

W635045.1